for selecting said condition from groups of possible conditions and an onscreen drug selection procedure for selecting said prescribed drug from said library.

82. A prescription according to claim 70 including information regarding dosing of a drug pursuant to formulary guidelines, said information being formulary-qualified according to said patient condition.

86. A prescription according to claim 70 further including a condition list comprising at least five conditions, and a drug list comprising at least five drugs.

87. A prescription according to claim 70 further including drug information comprising associated condition information and dosage information for at least about fifty percent of all prescribable FDA-approved drugs.

Remarks

On page 2 of the Office Action, the Examiner rejected claims 79, 82 and 86-87 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 79, 82 and 86-87 have been amended in order to clear the indefiniteness from its respective limitations, and thus should be allowable. Accordingly, the claims should be in condition for allowance.

Rejections under 35 U.S.C. § 102

On page 2 of the Office Action, the Examiner rejected claims 70-86 and 88-91 under 35 U.S.C. § 102(e) as being anticipated by Schrier et al. (U.S. Pat. No. 5,833,599). Applicant respectfully traverses this rejection.

Schrier et al. discloses systems and methods for processing data relating to use of a drug by a patient, that includes information relating to previously prescribed drugs for a particular patient. The systems and methods are characterized by a previous orders area 312 that is used to display previous drug orders for a patient and is limited to drugs sourced from the institution's pharmacy.

Applicant respectfully asserts that independent claim 70 of the instant application is patentably distinguishable over the Schrier et al. reference. In order for a reference to anticipate a claim, the reference must teach every element of the claim. In the instant application, claim 70 recites:

70. A prescription generated by a computer-implemented prescription creation system having a program stored on a computer-readable medium, the system being for use by a prescriber to create an electronic prescription prescribing a drug to treat a condition exhibited by a patient at a point-of-care, said electronic prescription comprising a patient identifier, at least one prescribed drug and at least one drug quantifier for the prescribed drug and being usable by a pharmacist to dispense the prescribed drug or drugs, said prescription creation system comprising:

a. a prescription creation screen having prescriber-operable data capture devices including:

i. a patient identifier data capture device for capturing patient-identifying data;

ii. a prescribed drug data capture device for capturing prescribed drug identification data;

iii. at least one drug quantifier capture device for capturing drug quantification data;

iv. a patient condition data capture device to capture patient condition data regarding said patient condition exhibited by said patient whereby said electronic prescription further comprises said patient condition data; and

b. a library of prescribable drug data accessible by one or more of said data capture devices from said prescription management screen to display multiple prescribable drugs;

c. a prescription output screen device to output a completed prescription; and

d. a printer to print the completed prescription;

wherein the completed prescription includes the patient condition and identification and quantification data regarding a drug prescribed by the prescriber user for treatment of the patient condition, the patient condition and drug data being captured into the prescription by the data capture devices.

Schrier et al. does not anticipate claims 70-86 and 88-91 because it does not show the use of prescription creation systems covered by "a patient condition data capture device to capture patient condition data regarding said patient condition exhibited by said patient whereby said electronic prescription further comprises said patient condition data." Rather, Schrier et al. discloses using previous orders area 312 for including only previous drug orders from the institution's pharmacy. There is no disclosure to use a patient condition capture device. Therefore, Schrier et al. does not anticipate claims 70-86 and 88-91.

Further, Schrier et al. does not render the present claims 70-86 and 88-91 obvious because it teaches away from the claimed invention. The claims of the instant application recite a patient condition data capture device to capture patient condition data regarding a patient condition exhibited by the patient whereby the electronic prescription further comprises the patient condition data and a library of prescribable drug data accessible by one or more of the data capture devices from the prescription management screen to display multiple prescribable drugs. Applicant discloses that the prescription creation system of the present invention, including the patient condition data capture device and the library to display multiple prescribable drugs, ensures that the patient condition is described and improves patient compliance while reducing potential errors or abuses. Thus, Schrier et al.'s disclosure of previous orders area 312 that is used only to display previous drug orders for a patient, the previous drug orders limited to drugs secured from the institution's pharmacy, is contrary to the claimed invention.

Additionally, with respect to Figure 11, Schrier et al. discloses an orders window 310 for displaying patient name, ID, age, location in the institution, and the patient's previous orders, with orders window 310 also having a previous orders area 312 to display previous drug orders for a patient, the previous drug orders limited to drugs sourced from the institution's pharmacy. Again, neither the previous orders area 312 nor the orders window 310 of Schrier et al. can be arranged into the patient condition data capture device of Applicant's invention. The patient condition data capture device, as illustrated in Figure 3 of the present invention, discloses a patient condition data capture device quite different from the previous orders area 312 discussed in Schrier et al.

Furthermore, regarding the Examiner's rejections of dependent claims 71-86 and 88-91, Applicant believes that since independent claim 70 is allowable in view of the Schrier et al. reference, dependent claims 71-86 and 88-91 are therefore allowable as well. In particular, claim 71 recites that the prescription creation system has at least one preferred usage data display, including a personal-preference drug selection list that tracks preferred data usage by each system user and automatically updates the preferred usage data display. Applicant respectfully disagrees with Examiner's assertion that these particular features are illustrated in Figure 10 of Schrier et al. Figure 10 of Schrier et al. teaches that a user may be asked to identify the condition for which the index drug would be used, that the user may enter and modify information about the patient's condition, and that upon the entry of such information, the system resets the knowledge base and drug-specific patient data. Column 8, lines 42-48. Schrier et al. fails to teach or disclose tracking of preferred data usage by the system, instead disclosing that the system resets the knowledge base and drug-specific patient data.

Moreover, Applicant respectfully disagrees with the Examiner's statement that Column 8, lines 42-46 describes what is recited in claim 74. Claim 74 recites that the patient condition list comprises patient conditions listed in the patient history record. As stated above, Column 8, lines 42-46 fails to teach or disclose patient conditions listed in the patient history records. Column 8, lines 42-46 of Schrier et al. teaches a system that updates and resets the knowledge base, not a system that maintains a record of such information. In fact, Applicant believes that Column 8, lines 42-46 discloses and teaches a system that overwrites (resets) patient history records in order to modify the knowledge base and drug-specific patient data.

Therefore, since Schrier et al. fails to teach or disclose the use of a patient condition data capture device, including a library to display multiple prescribable drugs, Applicant respectfully submits Schrier et al. does not anticipate or render obvious any of the pending claims. Accordingly, claims 70-86 and 88-91 are allowable in view of this reference and Applicant respectfully requests a withdrawal of this rejection.

Rejections under 35 U.S.C. § 103

On page 6 of the Office Action, the Examiner has also rejected claims 86-87 under 35 U.S.C. §103(a) as being unpatentable over Schrier et al. (U.S. Pat. No. 5,833,599).

Applicant respectfully traverses the rejections. Applicant respectfully submits that the reference is not proper, as the reference does not provide a motivation to have a list of drugs including 50% or more of the over 29,000 known FDA approved drugs. Even if proper, the reference does not render the claims obvious. At the outset, there is no motivation within the reference to have a list of drugs including 50% or more of the known FDA approved drugs. Schrier et al. discloses systems and methods for processing data relating to use of a drug by a patient, that includes information relating to previously prescribed drugs for a particular patient. Specifically, this system allows for a Choose A Drug Window 230 with a list of drugs 232 and a list of therapeutic categories 234.

The Examiner states that it would be obvious to take the list of drugs 232 of Schrier et al. with the knowledge of the skilled artisan to arrive at Applicant's invention (Office Action, page 6). However, there is no motivation to seek an improvement in the list of drugs 232 for Schrier et al., which discloses a drug list (drug database) configured in a manner to display drugs available in the formulary. In particular, Schrier et al. fails to disclose either a list of drugs including 50% or more of the over 29,000 FDA approved drugs or a list of conditions.

Rather, Schrier et al. discloses a system that requires information about the patient's condition to determine drug information (Column 8, lines 36-51). Thus, there is no motivation to improve the list of drugs 232 with the patient condition system (as illustrated in Figure 10) of Schrier et al., as the improvement would result in a list of drugs 232 that is contrary to the disclosure of Schrier et al. to have an index drug list with only two lists; a list of drugs 232 and a list of therapeutic categories 234 arranged in an adjacent manner. Therefore, these references teach away from combining them.

Further, Applicant submits that the list of drugs 232 of Schrier et al. would result in a system that lacks a Choose a Drug Window 230 displaying two lists (the list of drugs 232 on the left-hand side and the list of therapeutic categories 234 on the right-hand side) in favor of a system displaying more than two lists. Therefore, Schrier et al. fails to provide an enabling disclosure for lists of 50% or more of the over 29,000 FDA approved drugs and does not provide sufficient disclosure for providing a list of drugs with a condition list arranged in one display window. Applicant's invention, and specifically the combined use of a drug list and a condition list arranged in one display window, shows a dramatically improved drug list arrangement when compared with the list of drugs 232 disclosed in Schrier et al.

Even if this reference was proper, Schrier et al. does not disclose or render obvious Applicant's invention. Specifically, this reference and the reasons given by the Examiner for the combination do not disclose what is required by the Applicant's claims – a patient condition data capture device to capture patient condition data regarding the patient condition exhibited by the patient whereby the electronic prescription further comprises the patient condition data and a library of prescribable drug data accessible by one or more of the data capture devices from the prescription management screen to display multiple prescribable

drugs. This reference also does not teach or suggest a list of drugs expressly or inherently having the claimed requirements of Applicant's drug list. It is advantageous to provide a drug list that incorporates a condition list and has both lists arranged in one display window. One advantage to using the drugs list with integrated condition list of the present invention is that the system requires less navigation of categories. Thus, the list of drugs of Schrier et al. is unsuitable.

The Examiner has failed to establish a prima facie case for obviousness of claims 86-87. It is the Examiner's burden to show that the prior art relied upon coupled with the knowledge generally available in the art at the time of the invention must contain a suggestion or incentive that would have motivated one of ordinary skill in the art to combine references. As Applicant has set forth throughout this response, the distinctive differences between the single reference and the art makes the improvement of the reference implausible. The Examiner must also show that the proposed combination must have a reasonable expectation of success. It is inappropriate for the Examiner to use the present application as a motivation to combine the reference with the skilled artisan. Taking bits and pieces from a reference in an attempt to create Applicant's invention is improper.

Therefore, since Schrier et al. fails to teach or disclose a drug list, including a condition list, Applicant respectfully submits it does not anticipate or render obvious any of the pending claims.

Thus, Applicants respectfully request reconsideration and withdrawal of the §103 rejection as to these claims.

Conclusion

Having analyzed the rejections cited against the claims, it is urged that the present claims are in condition for allowance. A favorable reconsideration is requested. The Examiner is invited to contact the undersigned attorney to discuss any matters pertaining to the present application.

A marked version of the amended claims showing where changes have been made is attached hereto.

Respectfully submitted,

By: _____

June 13, 2003

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Certificate of Mailing under 37 CFR 1.10

I hereby certify that this Amendment with enclosed Revocation of Power of Attorney, Power of Attorney and Statement under 37 CFR 3.73(b) are deposited with the United States Postal Service "Express Mail Post Office to Addressee: service under 37 CFR 1.10 on the date indicated above and addressed to: Mail Stop Non-Fee Amendment, **Commissioner for Patents, Alexandria, VA 22313-1450, on June 13, 2003.**

Vernice V. Freebourne

June 13, 2003
Date